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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,951

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EXAMINER

KHATRI, PRASHANT J

ART UNIT

PAPER NUMBER

1783

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,951	<b>Applicant(s)</b> IKEDA ET AL.	
	<b>Examiner</b> PRASHANT J. KHATRI	<b>Art Unit</b> 1783	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/22/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In response to RCE filed 10/22/2010. Claims 41-46 are pending. Claim 41 was amended.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2010 has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 41-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 41 recites the limitation of "non-solvent ultraviolet ray hardening resin". Since the claimed article appears to be a finished article (i.e. after processing), the resultant article after drying and the like, the finished article would not have solvent

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within the system. Based upon the specification, it appears that "non-solvent" actually is considered to be an aqueous dispersion and not "non-solvent" in the broad sense.

Clarification is requested.

5. Claim 41 also recites the limitation "said decorative layer including adjacent decorative layer portions corresponding with said ink pattern portions and respectively containing corresponding greater and lesser amounts of absorbed hardening resin". It is not clear as to how this is structurally different from the previous limitation of the ink pattern portions containing inks that absorb greater and lesser amounts of hardening resin. Additionally, it is not clear what is meant by the decorative layer including adjacent decorative layer portions, whether these adjacent decorative layers are separate structures, or where these would be located with respect to the overall decorative layer. Clarification is requested.

6. Claim 46 recites a water pressure transfer article and claim 41, upon which claim 46 depends, recites the completed article. It is not clear what is being claimed in claim 46 since claim 46 appears to recite an article prior to processing and claim 41 recites a finished article. Claims 42-45 are rejected as being dependent upon claim 41.

Clarification is requested.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 41-44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobunao et al. (***JP 2001-315287***).

9. Nobunao et al. disclose a decorative material. Concerning claims 41 and 44, Nobunao et al. disclose an article having a surface decorative layer that is comprised of a resin absorptivity patterned ink that is colored with particles and a topcoat resin layer wherein at least a portion of the topcoat resin layer is absorbed by the resin absorptive pattern (***Abstract; FIGS. 1-2; para. 0054***). The topcoat resin layer can be comprised of a non-solvent (i.e. aqueous) UV hardening material based upon a human spot translation of these paragraphs (***para. 0034-0035, 0058***). Regarding the amount of low gloss and high gloss regions, Nobunao discloses that the composition has a surface gloss that is high and that the gloss can be adjusted with the use of matting agents (***para. 0059***). Given that Nobunao discloses controlling the gloss by means of matting agents, it is clear that one of ordinary skill in the art would have been able to control the gloss by controlling the amount of matting agents. Further, given that Nobunao discloses that the ink layer is patterned and may be colored, the one of ordinary skill in the art would be able to form a desired pattern that would allow for greater and lesser

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amounts of hardening resin based upon the amount of ink that is disposed upon the surface absorbed since a pattern intrinsically would have portions where there is ink and where there is no ink or little ink (i.e. varies based upon the pattern that is disposed) and as such, lesser and greater absorbed regions (**FIGS. 1-2; para. 0049-0056**).

Concerning claim 43, it is noted that the topcoat resin layer would have matting agents (**para. 0059**).

While it is noted that Nobunao is silent to such a layer applied to the article by means of transfer under water pressure, it is noted that such a limitation is a product-by-process limitation. Although Nobunao et al. does not disclose the use of such a layer as applied to the surface of an article by transfer under water pressure, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed transfer under water pressure and given that Nobunao et al. meets the requirements of the

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claimed composite, Nobunao et al. clearly meet the requirements of present claims 41 and 46.

10. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nobunao et al. (**JP 2001-315287**) as applied to claim 41 above, and further in view of Wypych (**Book**).

11. Nobunao discloses the above but is silent to the particle colorant being black.

12. Wypych discloses carbon black as pigment for ink compositions in which the use of carbon black in creating tinted inks is known within the art as far back as 3000 B.C. (**p. 62-71**). Given that Nobunao discloses formulating printing inks with colorants that include particles (**para. 0054**) and Wypych discloses carbon black is used in printing inks, it is clear that such materials are well-known within the art and would have been obvious to one of ordinary skill in the art to use accordingly.

### ***Response to Arguments***

13. Applicant's arguments, see pp. 2-7, filed 10/22/2010, with respect to the 35 USC 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections and 35 USC 103(a) rejections of claims 41-46 have been fully considered and are persuasive. The rejections of the above claims have been withdrawn. However, it is noted that upon further reconsideration, Wypych is still applicable to the present claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRASHANT J. KHATRI whose telephone number is (571)270-3470. The examiner can normally be reached on M-F 8:00 A.M.-5:00 P.M. (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L. Nordmeyer/  
Primary Examiner, Art Unit 1788

PRASHANT J KHATRI  
Examiner  
Art Unit 1783